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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1944.

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No. 472
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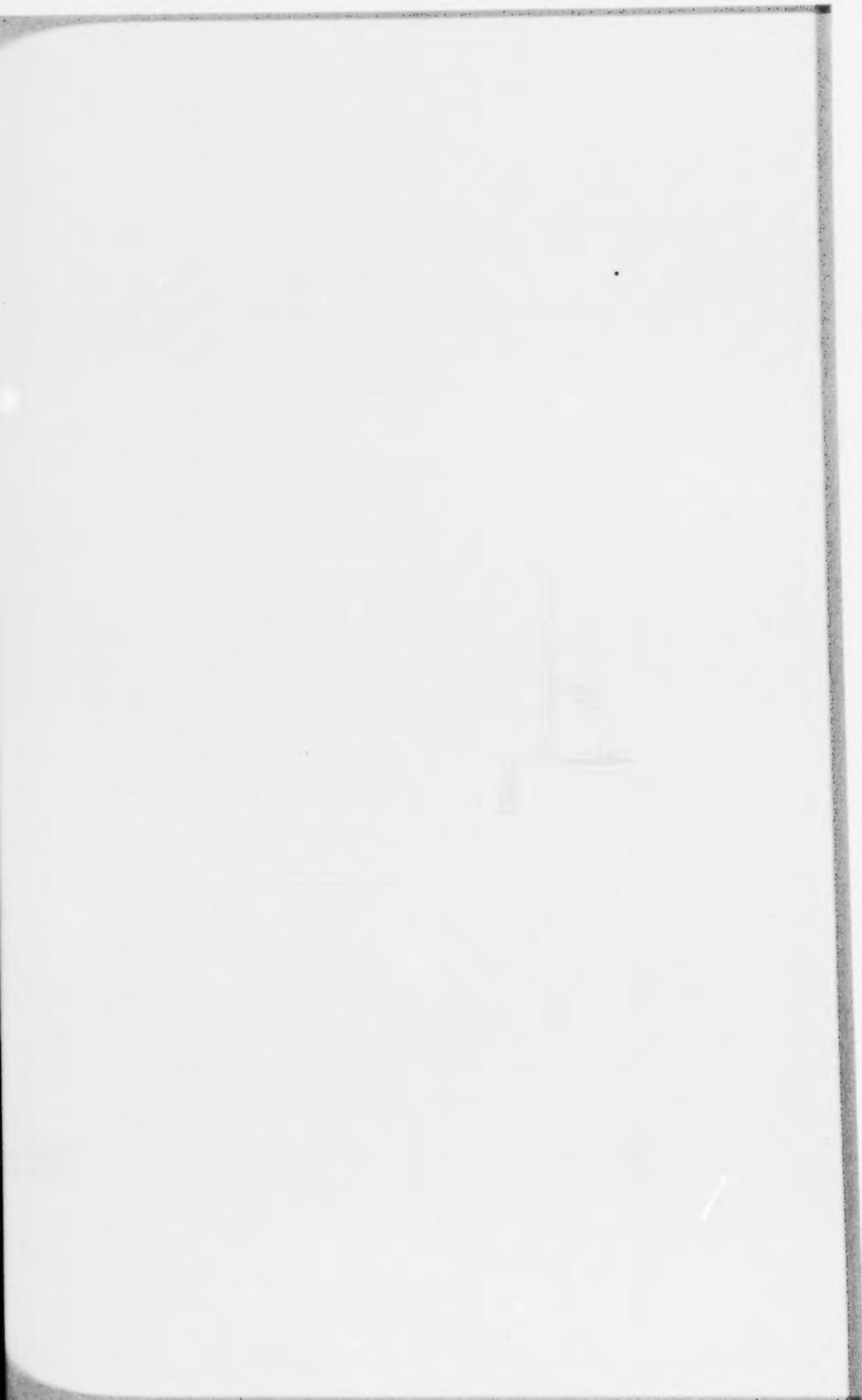
GALLAND-HENNING MANUFACTURING COMPANY,
Petitioner,
vs.

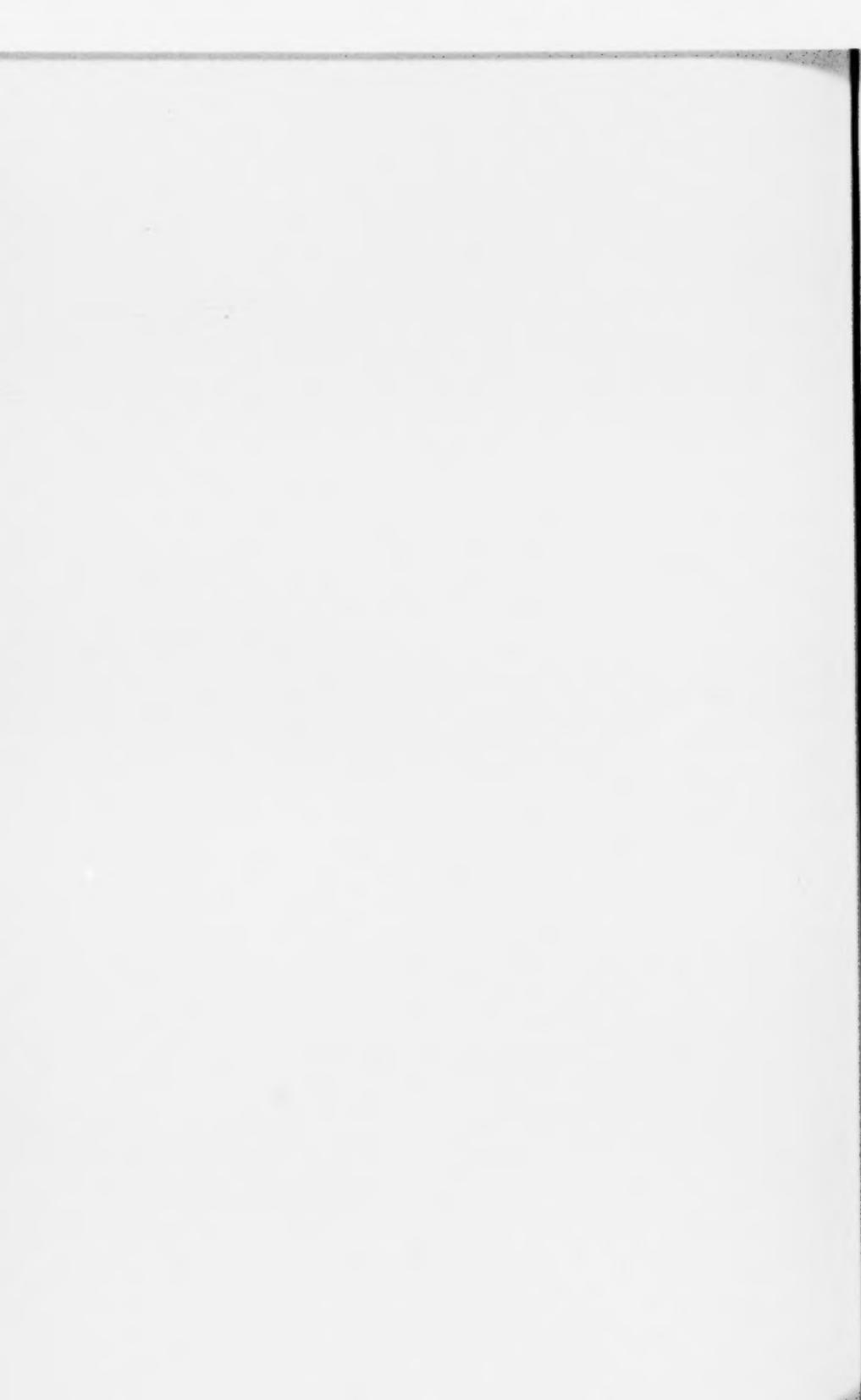
LOGEMANN BROTHERS COMPANY,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

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DEFENDANT'S SUPPLEMENTAL STATEMENT.

The patent in suit has been adjudicated by only one District Court and one Circuit Court of Appeals (the Seventh Circuit), and they agreed in dismissing the Complaint.

The evidence is undisputed, the structure exceedingly simple, and the Appellate Court was in just as good a position as the District Court to pass on the validity of the patent.

The District Court found invention only as to a combination which it also found to be not embodied in Defendant's accused structure. The Court of Appeals gave the claims a different interpretation and held them void. The difference is primarily one of claim interpretation and, secondly, one of law as to the legal effect of undisputed facts applied to differently interpreted claims.

ARGUMENT.

The Petition is without merit for the following reasons:

I.

The District Court made no unqualified finding of invention. Its findings of invention and non-infringement are *interdependent and inseparable* as demonstrated by the following quotations from the findings (Tr. 88-90) :

“Jacobson, Plaintiff’s assignor, added a transversely operating gathering ram to a standard two compression press.” (Finding 2.)

“To increase the width of the press box in which initial compression is effected, to enable such box to receive larger scrap, whereas in Defendant’s accused press there is no means for increasing the width of the press box.” (Finding 10.)

“Plaintiff’s patent strongly emphasizes in the specification as well as in the claims the manner and the order in which the compressions are effected.” (Finding 4.)

“Each of the claims in issue is a combination claim specifying a particular order of ram operation.” (Finding 5.)

“In Defendant’s accused device, the order of ram operation is not followed. In the accused press the order of ram operation is the same as that of the prior art Jacobson and Kruse 1,766,642. The rams are the same and their working faces are the same as those made by the Defendant under that patent.” (Finding 6.)

On the basis of these undisputed evidentiary facts, the District Court arrived at the following conclusions of fact:

“The art relating to baling presses is quite highly developed and the claims of the patent in suit must be narrowly construed in view of the limitations imposed

by the prior art. Thus construed, Jacobson's development constitutes invention." (Finding 3.)

"Defendant's accused press structure is manifestly excluded from the scope of the invention of the patent in suit as described in the specification and set forth in the claims thereof." (Finding 12.)

"The claims of the patent in suit are not readable upon the structure of Defendant's accused press." (Finding 13.)

Then as conclusions of law the District Court found the patent valid but not infringed by Defendant's non-equivalent structure.

The Court of Appeals ignored the finding that the claims are limited to include a gathering ram not found in Defendant's structure, but discussed the words "longitudinal" and "transverse" in the claims and treated these words as inept and not words of limitation, concluding their discussion of this phase in the following words:

"We think such subtle refinements cannot constitute a valid basis for the issuance of a patent or a defense against infringement." (Tr. 203.)

And in the last paragraph of the opinion, the Court said:

"There is no substantial controversy as to any evidentiary fact. We have before us models of the patent in suit, the alleged infringing device, and the former patent to Jacobson and Kruse which was declared invalid by this Court. This case may be determined by a mere comparison of these structures and extrinsic evidence is not needed for explanation, or evaluation of the prior art, or to resolve questions of the applications of descriptions to the subject matter. We are convinced that the disclosures do not disclose patentable invention. The District Court did not err in dismissing the bill of complaint for want of equity." (Tr. 207.)

It will be observed that the Appellate Court did not deny that the addition of a gathering ram to a two ram press

might have involved invention *at one stage of the art*, but held that:

“There are four ultimate facts which must exist before an invention is patentable,—authorship, ownership, novelty not as a result of mechanical skill, and utility. If they exist concurrently, the disclosure is patentable. If one is lacking, it is not patentable. This must be true, not because the finder of facts says so but because the statute says so.” (Tr. 205.)

In so deciding, the Court of Appeals for the Seventh Circuit is in complete harmony with the decision of this Court in *Milburn etc. v. Bavis-Bourbonville*, 270 U. S. 390-402, from which we quote the next to the last sentence of the opinion:

“The fundamental rule, we repeat, is that the patentee must be the first inventor.”

In the case at bar, the patentee was not the first to introduce a gathering ram into a baling press. See Spencer patent of 1906 (Tr. 112). He merely aggregated such a ram with an ordinary two ram press to produce a three ram press differing from the Jacobson and Kruse press (Tr. 170), by substituting a gathering ram for the prior art high pressure ram at the other end of the box. See comparative exhibit diagrams (Tr. 72-78).

The fact that the District Court and the Appellate Court could so radically differ as to the meaning of the claims in suit shows that the claims in any event are void for indefiniteness. *General Electric Co. v. Wabash Corp.*, 304 U. S. 364, p. 369; *United Carbon Co., et al. v. Binney & Smith Co.*, 317 U. S. 228, p. 233.

II.

The first question or specification of error sought to be raised by the Petition, viz.—whether Rule 52a applies to ultimate facts as well as evidentiary facts, is entirely moot.

If the Court of Appeals erred in disregarding the evidentiary facts stated in Findings 4 to 11, inclusive, as made by the District Court and on which the Conclusion of non-infringement is based, that error was prejudicial to the Defendant,—not to the Petitioner,—for those Findings are based on ample, undisputed evidence of non-infringement of the claims as the District Court interpreted them.

Petitioner cannot play fast and loose with Rule 52a,—using it for its own benefit and disregarding it when considering findings favorable to Defendant.

III.

The second question or error assigned by the Petition is whether an Appellate Court can set aside a clearly erroneous Finding of Fact without expressly stating that it is clearly erroneous, or that there is no evidence to support it. This question is also moot, for the Appellate Court clearly stated its position in that portion of its Opinion appearing on page 204 of the Transcript from which we quote the following:

“The Plaintiff contends that if it appears from the findings of the court that the claims of a patent disclose an invention over the prior art, such findings of fact, if supported by evidence, will not be set aside by an appellate court. *With this contention we are in accord.*” (Italics ours.)

No other Circuit Court of Appeals ever went any further, or could have gone any further, in imparting inflexibility to Rule 52a as to findings of ultimate fact. Having

expressly recognized the rule, and having then found the patent invalid, the Court of Appeals has, in substance, ruled that on the evidence the finding of validity by the trial court was clearly erroneous.

Petitioner is not justified in quibbling over the form of words. It clearly appears that the court considered itself bound by Rule 52a, as stated in the above quotation from page 204 of the Transcript. The rule discussed on the last page of the Opinion is not Rule 52a but the rule that questions of invention, infringement, and validity may be regarded as questions of law when the evidentiary facts are undisputed.

This is the rule which the Court is discussing in the following quotation taken from page 207 of the Transcript, viz.:

“ ‘Where, with all the evidence before the court, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject-matter, the questions of invention and infringement may be determined as questions of law.’ This case may be determined by a mere comparison of these structures, and extrinsic evidence is not needed for explanation, or evaluation of prior art, or to resolve questions of the applications of descriptions to the subject matter. We are convinced that the disclosures do not disclose patentable invention. The District Court did not err in dismissing the bill of complaint for want of equity.” (Tr. 207.)

Where the evidence is undisputed, invention, lack of equivalence, and non-infringement are questions of law.

Smith v. Nichols, 88 U. S. 112, p. 118.

Mahn v. Harwood, 112 U. S. 354, p. 358.

Himmel Brothers Co. v. Serrick Corp., 122 F. (2d) 740, pp. 742-743.

IV.

The third and last assigned error is also moot. Certainly ever since the date of *Mahn v. Harwood*, 112 U. S. 354, Appellate Courts have not hesitated to reverse findings of invention where undisputed evidence or a mere inspection of the exhibits showed the structure claimed to be the result of mere mechanical skill.

The *Detrola* case, 313 U. S. 259, is one of the last utterances of the Supreme Court on this question, and in citing it, Petitioner overlooked the fact that it squarely supports the decision of the Circuit Court of Appeals in the case at bar.

The concluding paragraph of the Opinion of this Court in the *Detrola* case reads as follows:

“We conclude that Wheeler accomplished an old result by a combination of means which, singly or in similar combination, were disclosed by the prior art and that, notwithstanding the fact he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, he was not in fact the first inventor, since his advance over the prior art, if any, required only the exercise of the skill of the art.”

Detrola v. Hazeltine, 313 U. S. 259-269.

In the case at bar, the undisputed evidence shows that three ram presses were old (Tr. 170) and that Jacobson's three ram press merely involved adding a known gathering ram to a standard two ram press (Tr. 160) to produce a press of variable width, and that such gathering rams were old and disclosed in Figure 2 of a prior patent to Spencer (Tr. 114), (not a file wrapper reference). On the following pages, diagrams are reproduced of Defendant's Exhibits F-2 and F-3, in which the gathering ram of the patent in

suit (Defendant's Ex. F-2), is compared with that of the Spencer patent (Defendant's Ex. F-3), and shown to involve identical conceptions designed for the same purpose of widening a press box to receive bulky material. The Spencer patent is dated May 1, 1906. Therefore, there could be no dispute as to its priority. Spencer, and not Jacobson, did the designing necessary to provide a gathering ram, which then must be first operated to push the bulky material into the path of a longitudinally movable ram.

A mere inspection of these exhibits shows that the patent in suit is void as an aggregation of Spencer's gathering ram with a prior art two ram scrap metal baling press.

Conclusion.

For the foregoing reasons, it is urged that the Petition be denied, with costs.

Respectfully submitted,

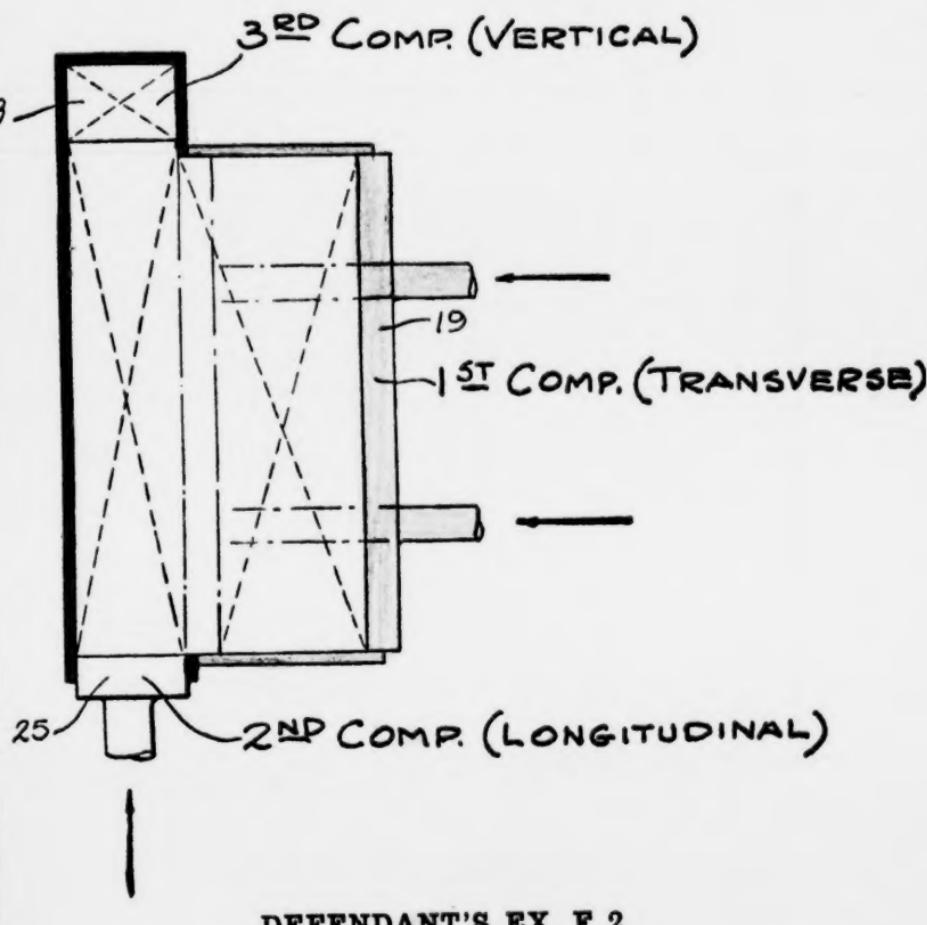
LOGEMANN BROTHERS COMPANY,
Defendant-Respondent,
By S. L. WHEELER,
Of Counsel.

Proof of Service.

Received 3 copies of Respondent's Brief in Opposition to Petition for Writ of Certiorari this 5th day of October, 1944.

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Counsel for Petitioner.

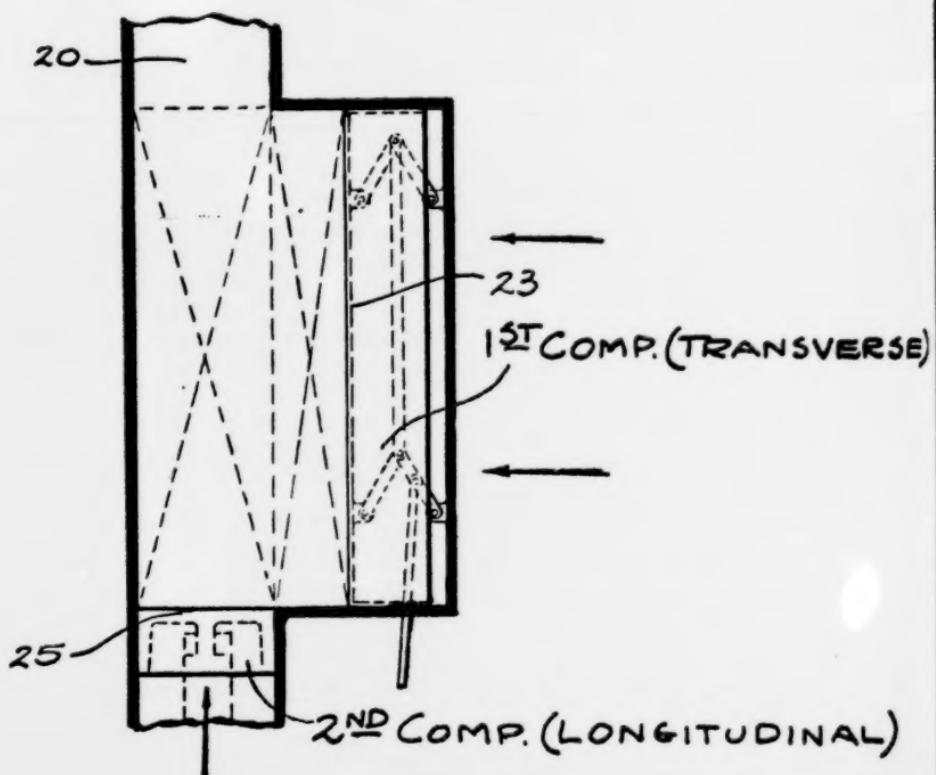
PLAN OF PRESS BOX OF PATENT IN SUIT



DEFENDANT'S EX. F 2

SPENCER PATENT 819,319 MAY 1, 1906

PLAN OF PRESS BOX



DEFENDANT'S EX. F 3

